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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,480	02/11/2004	Daniel Luch		5994

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Morgan Hill, CA 95037

EXAMINER

WONG, EDNA

ART UNIT	PAPER NUMBER
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1753

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/776,480

Applicant(s)

LUCH, DANIEL

Examiner

Edna Wong

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2006 and 28 June 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-9 is/are pending in the application.
- 4a) Of the above claim(s) 7-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date May 16, 2006.
- ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date July 14, 2006.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

This is in response to the Amendment dated May 16, 2006 and June 28, 2006.
The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

Drawings

The drawings have been objected to because "Fig. 12:" should be amended to --
Fig. 121 --.

The objection of the drawings has been withdrawn in view of Applicant's amendment.

Specification

The disclosure has been objected to because of minor informalities.

The objection of the disclosure has been withdrawn in view of Applicant's amendment.

Claim Rejections - 35 USC § 112

Claim 1 has been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection of claim 1 under 35 U.S.C. 112, second paragraph, has been

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withdrawn in view of Applicant's amendment. Claim 1 has been cancelled.

Claim Rejections - 35 USC § 102

Claim 1 has been rejected under 35 U.S.C. 102(b) as being anticipated by **van Dijk et al.** (US Patent No. 5,338,413).

The rejection of claim 1 under 35 U.S.C. 102(b) as being anticipated by van Dijk et al. has been withdrawn in view of Applicant's amendment. Claim 1 has been cancelled.

Response to Amendment

Drawings

The drawings were received on May 16, 2006. These drawings are approved by the Examiner.

Election/Restrictions

Newly submitted claims **7-9** are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 7-9 are directed to an article. The originally presented claim was directed to a method.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

prosecution on the merits. Accordingly, claims 7-9 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

Claims 2 and 4 are objected to because of the following informalities:

Claim 2

line 3, the “;” (semicolon) should be amended to a -- : -- (colon).

Claim 4

line 2, the “;” (semicolon) should be amended to a -- : -- (colon).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4

lines 4 and 6, the claim has two periods.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I. Claims **2 and 3** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Say et al.** (US Patent No. 6,103,033) in combination with **Kim et al.** (US Patent No. 6,587,705 B1).

Say teaches a method for continuous (col. 2, lines 14-16) depositing of a metal-based deposit **64** (= depositing a sensing layer) [col. 31, lines 8-12; and col. 33, lines 29-43] onto at least a portion **54** (= channels) of the surface of an article **50** (col. 6, lines 50-56) wherein said portion is formed by an electroplateable material **56** (col. 9, lines 32-40) [col. 15, lines 43-46; and 3A and 3B], the improvement comprising:

formulating said electroplateable material comprising an electrically conductive polymer (= a conductive polymer) [col. 9, lines 32-40].

The electrically conductive polymer is a directly electroplateable resin (DER) [= a conductive polymer] (col. 9, lines 32-40).

The method of Say differs from the instant invention because Say does not disclose wherein the plating is electroplating, as recited in claim 2.

Say teaches that sensor chemistry can be applied at the sensor chemistry application station **326** by a variety of techniques. Exemplary techniques include piezo jet printing, ink jet printing, spraying, flowing the sensor chemistry onto the electrodes, coating chemistry on the electrodes, or any other techniques suitable for applying chemistry to a relatively precise location (col. 33, lines 29-38).

Like Say, Kim teaches biosensors. Kim teaches that the electrode composition can be affixed to the surface in any suitable pattern or geometry, and can be applied using various thin film techniques, such as sputtering, evaporation, vapor phase deposition, or the like; or using various thick film techniques, such as film laminating, electroplating, or the like. Alternatively, the composition can be applied using screen printing, pad printing, inkjet methods, transfer roll printing, or similar techniques (col. 13, lines 17-31).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the depositing described by Say with wherein the depositing is electroplating because Say teaches that sensor chemistry can be applied at the sensor chemistry application station by a coating chemistry on the electrodes (col. 33, lines 29-38). Electroplating would have been a suitable coating chemistry because it would have affixed the composition to the surface in any suitable pattern or geometry as taught by Kim (col. 13, lines 17-31).

II. Claims **4-6** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Say**

et al. (US Patent No. 6,103,033) in combination with **Kim et al.** (US Patent No. 6,587,705 B1).

Say is as applied for reasons as discussed above and incorporated herein.

Say also teaches wherein said article comprises a web **202** (col. 28, lines 58-62).

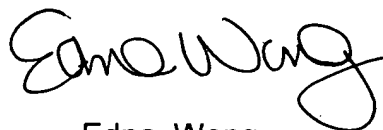
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (571) 272-1349. The examiner can normally be reached on Mon-Fri 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Edna Wong
Primary Examiner
Art Unit 1753

EW
September 1, 2006